

USSN 10/731,854

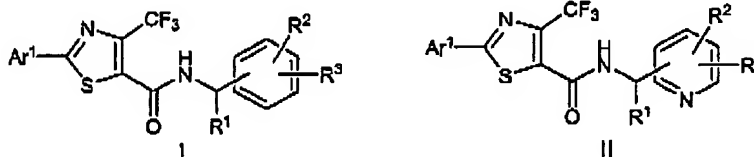
CT-2709 NP

Remarks

Status of the claims. Claims 1 and 3-17 are pending. Claim 2 has been cancelled. Claims 3, 4, 9 and 12-27 were withdrawn from consideration by the examiner. Claim 1 was rejected under 35 USC 112. Claims 2, 5-8, 10, and 11 were objected to as being dependent on a rejected claim.

Restriction requirement. The applicants wish to clarify several points concerning the restriction requirement.

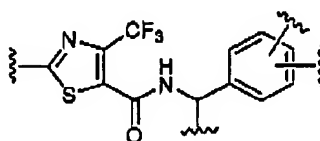
First, the applicants elected group I. The restriction limits claims to compounds where Q¹ is CH as shown below. The scope of the compound claims is now defined by claims 1-11 where terms for Q¹ = N have been deleted (group II, shown below). The examiner, however, did not consider claims 3, 4, or 9 which contain elected subject matter.



Second, with claim 1 amended to Q¹ being CH, claim 2 was redundant and was cancelled.

Third, the examiner generated a subgenus in addition to the restriction requirement and limited her examination to this smaller subgenus. The applicants respectfully traverse this further restriction of their invention.

Under *In re Weber*, an applicant has a statutory right to "claim his invention with the limitations he regards as necessary" so long as the application comply with 35 USC 112. *Weber* states that an examiner may not "refus[e] to examine a broad generic claim no matter how broad, which means no matter how many independently patentable inventions may fall within it." The PTO has adopted this decision for Markush claims so long as the claimed compounds share a common utility and a substantial structural feature. The fact that variables create independent and distinct inventions does not overcome this decision so long as the unity of invention is met. The compounds of this application do share a common utility and a substantial structural feature (shown below).



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The applicants have addressed all 112 issues and note that no prior art has been cited against the subgenus. They therefore respectfully request the examiner to examine claim 1 on the merits.

Finally, The applicants intend to rejoin method of use claims 12-17 for allowed compound claims under MPEP 821.04.

Rejection under 35 USC 112. The examiner rejected claim 1 for not being enabled with respect to the term "solvate." The applicants deleted the term solvate in claim 1. The applicants found no other occurrences of this term in other claims.

The applicants believe the application is now allowable and respectfully request favorable reconsideration. If any issues remain regarding the allowance of this application, the examiner is respectfully invited to contact the applicants' agent, James Epperson, by phone (203-677-6974), fax (203-677-6900), or e-mail (james.epperson@bms.com).

Respectfully submitted,

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